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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No. 3523
WEI *et al.*	Art Unit: 1646
Appl. No. 09/826,212	Examiner: O'Hara, E.B.
Filed: April 5, 2001	Atty. Docket: 1488.1280006/EKS/EJH
For: **Tumor Necrosis Factor Receptor 5**	

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **June 10, 2002**, requesting an election of one group to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the subject matter of Group I as defined by the Examiner, represented by claims 23-87, and 101-116. This election is made without prejudice to or disclaimer of the other claims or subject matter disclosed. This election is made with traverse.

With respect to the division of the claims into seven groups and the reasons stated therefor, Applicants respectfully traverse. Groups I through VII are related as drawn to polypeptides of SEQ ID NO:2. Even assuming, *arguendo*, that Groups I through VII represent distinct or independent subject matter, Applicants submit that to search and examine the subject matter of the groups together would not be a serious burden on the Examiner. Applicants submit that there is significant overlap between the polypeptides of Groups I through VII as evidenced by the identity in classification. This significant overlap thereby makes it a simple matter for the Examiner to search and examine publications disclosing SEQ ID NO:2. The M.P.E.P. § 803, states:

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent subject matter, restriction remains improper unless it can be shown that the search and examination of all groups would entail a "serious burden." M.P.E.P. § 803. In the present situation, no such showing has been made.

Applicants submit that a search of the sequence of Group I would provide useful information for the sequence of Groups II-VII. Indeed, since Groups II-VII are directed to *portions of the same sequence* (SEQ ID NO:2) of Group I, a search of the groups would largely, if not entirely, overlap. Because the searches for sequence of Groups I and II-VII would overlap, the search and examination of all groups would not entail a serious burden.

Further, Applicants point out that the Examiner has not addressed MPEP § 803.04, directed to nucleotide sequences. Pursuant to the notice *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996), §803.04 holds that even when nucleotide sequences encoding different proteins are contained in an application, a reasonable number, normally ten, sequences will be examined in a single application. Applicants submit that the instant amino acid sequences constitute different fragments of the same protein, rather than different proteins as contemplated by § 803.04. "[N]ucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together." Thus, Applicants respectfully submit that the present requirement for election is improper. However, even if the Examiner contends that the instant amino acid sequences constitute different proteins within the scope of §803.04, Applicants submit that a reasonable number of such sequences should be

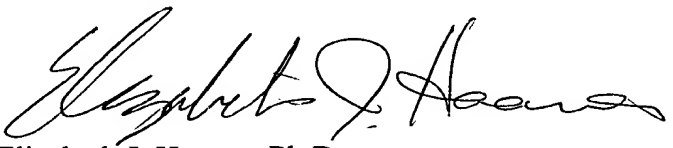
examined together, and the Examiner has given no indication why the search of seven sequences is unreasonable in the present case.

Thus, Applicants respectfully request that the Restriction Requirement be withdrawn so the subject matter of Groups I and II-VII can be examined together.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: July 9, 2002

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July 9, 2002

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Commissioner for Patents
Washington, D.C. 20231

Art Unit 1646

Re: U.S. Utility Patent Application
Appl. No. 09/826,212; Filed: April 5, 2001
For: **Tumor Necrosis Factor Receptor 5**
Inventors: Wei *et al.*
Our Ref: 1488.1280006/EKS/EJH

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction Requirement; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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EJH/PAC:drb
Enclosures
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